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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,410	06/04/2001	Shell S. Simpson	10007651-1	5595
<div>7590 11/02/2007 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400</div>			<div>EXAMINER SHINGLES, KRISTIE D</div>	
			<div>ART UNIT 2141</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 11/02/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/874,410

Applicant(s)

SIMPSON ET AL.

Examiner

Kristie D. Shingles

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-14 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Per Applicant's Request for Continued Examination

No claims have been amended.

Claims 10, 15, 16 and 22-24 have been cancelled.

Claims 1-9, 11-14 and 17-21 are pending.

Continued Examination Under 37 CFR 1.114

I. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/20/2007 has been entered.

Response to Arguments

II. Applicant's arguments with respect to claims 1-21 have been considered but are not persuasive in light of the defective declaration.

37 CFR 1.131 - AFFIDAVIT/DECLARATION

III. The declaration filed on July 5, 2005 under 37 CFR 1.131 has been considered is insufficient to overcome the *Pineau* reference.

A. FORMALITIES

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

Art Unit: 2141

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935). (MPEP 715.04)

In this case, the declaration only includes the signature of an attorney, Roger D. Greer. Since there has been no petition filed under 37 CFR 1.47(a) validating the attorney's signature for the inventors, the signature of the attorney is not valid.

B. SUBSTANCE

Applicant is attempting to rely on reduction to practice prior to the effective date of the reference (*Pineau* on May 30, 2001).

CONCEPTION

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date,

Art Unit: 2141

without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). (MPEP 715.07)

In this case, the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the *Pineau* reference.

Applicant relies on Exhibit A (email documentation) to establish conception of the applicant's claimed invention; however no evidence in the email records discloses descriptive documentation of substantive evidence of the invention. Thus the exhibit submitted fails to provide sufficient evidence to support the conception of the claimed invention and a redacted date is a date prior to the May 30, 2001.

DILIGENCE

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with

Art Unit: 2141

the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). (MPEP 715.07(a))

In this case, Applicant declares that both the conception and reduction to practice occurred before May 30, 2001, however this has not been established since no evidence supporting the conception of the claimed invention prior to May 30, 2001 has been submitted. Furthermore, diligence is lacking and there exists no proof of the actual reduction to practice prior to the effective date of the *Pineau* reference (including, no indications of repeated successful testing prior to the effective date of *Pineau*).

The Examiner notes that the substantive comments are merely for guidance and are not comprehensive. The affidavit is deficient on its face because of improper execution.

Claim Rejections - 35 USC § 103

IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

V. **Claims 1-9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Adamske et al* (US 6,615,234) in view of *Pineau* (US 2002/0181010).**

Regarding claim 1, *Adamske et al* teach a system for preparing imaging data for printing to a requested web service from an application loaded on a user's computing device, comprising:

- an imaging client computer having a web browser for printing from the application to the requested web service (*col.3 lines 51-55*);

Art Unit: 2141

- an imaging repository for storing imaging data comprising digital data capable of being represented as two dimensional graphics that is to be accessed by the requested web service (*col.2 lines 8-16 and 19-22, col.3 lines 64-67, col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*);
- a capture driver for preparing the imaging data for transfer to said personal imaging repository (*col.3 lines 56-61, col.6 lines 34-39*), said capture driver further comprising:
- a printer driver for converting the imaging data into a predefined format suitable for printing to a peripheral device (*col.3 lines 56-61, col.6 lines 34-39*);
- an uploader mechanism for storing the imaging data into said personal imaging repository (*col.3 lines 51-55, col.5 lines 15-16*); and,
- a conversion mechanism for converting the imaging data into the default format of the personal imaging repository (*col.2 lines 8-16, col.6 lines 5-8*).

Adamske et al fails to teach a personal imaging repository associated with a particular user for storing imaging data, and wherein said personal imaging repository is an exchange infrastructure between the imaging data and available web services on the Internet; and a port monitor for directing the imaging data to said personal imaging repository. However, *Pineau* teaches a personal imaging repository associated with a particular user for storing imaging data comprising digital data capable of being represented as two dimensional graphics that is to be accessed by the requested web service, and wherein said personal imaging repository is an exchange infrastructure between the imaging data and available web services on the Internet (*Figure 2b, page 3 section 0035, page 4 sections 0044-0048, page 5 sections 0049-0052 and 0055*); a port monitor for directing the imaging data to said personal imaging repository (*page 5 section 0053*).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system and method for network based document

Art Unit: 2141

delivery of *Adamske et al* with *Pineau* by having a personal imaging repository associated with a particular user for storing imaging data, and wherein said personal imaging repository is an exchange infrastructure between the imaging data and available web services on the Internet; and a port monitor for directing the imaging data to said personal imaging repository because a personal repository that is an exchange infrastructure allows a user to access said personal image data from anywhere at anytime and having a port monitor for directing the imaging data to said personal imaging repository because the port monitor is used to transfer information and for the verification of information.

Regarding claim 14, *Adamske et al* teach a computer for preparing imaging data for printing from an application to a requested web service, comprising:

- a web browser for printing to the requested web service (*col.3 lines 51-55*);
- an imaging repository for storing imaging data comprising digital data capable of being represented as two dimensional graphics that is to be accessed by the requested web service (*col.2 lines 8-16 and 19-22, col.3 lines 64-67, col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*),
- a capture driver for preparing said imaging data for transfer to said personal imaging repository (*col.3 lines 56-61, col.6 lines 34-39*), said capture driver further comprising:
 - a printer driver for converting the imaging data into a predefined format suitable for printing to a peripheral device (*col.3 lines 56-61, col.6 lines 34-39*);
 - an uploader mechanism for storing the imaging data into said personal imaging repository (*col.3 lines 51-55 and col.5 lines 15-16*); and,
 - a conversion mechanism for converting the imaging data into the default format of the personal imaging repository (*col.2 lines 8-16 and col.6 lines 5-8*).

Adamske et al fails to teach a personal imaging repository associated with a particular user for storing imaging data, and wherein said personal imaging repository is an exchange

Art Unit: 2141

infrastructure between the imaging data and available web services on the Internet; and a port monitor for directing the imaging data to said personal imaging repository. However, *Pineau* teaches a personal imaging repository associated with a particular user for storing imaging data comprising digital data capable of being represented as two dimensional graphics that is to be accessed by the requested web service, and wherein said personal imaging repository is an exchange infrastructure between the imaging data and available web services on the Internet (*Figure 2b, page 3 section 0035, page 4 sections 0044-0048, page 5 sections 0049-0052 and 0055*); a port monitor for directing the imaging data to said personal imaging repository (*page 5 section 0053*).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system and method for network based document delivery of *Adamske et al* with *Pineau* by having a personal imaging repository associated with a particular user for storing imaging data, and wherein said personal imaging repository is an exchange infrastructure between the imaging data and available web services on the Internet; and a port monitor for directing the imaging data to said personal imaging repository because a personal repository that is an exchange infrastructure allows a user to access said personal image data from anywhere at anytime and having a port monitor for directing the imaging data to said personal imaging repository because the port monitor is used to transfer information and for the verification of information.

Regarding claim 2, *Adamske et al* with *Pineau* teach the system as defined in claim 1 wherein said imaging client computer further comprising user information for associating the user with said personal imaging repository (*Adamske et al—col.7 lines 4-9 and 16-27*).

Regarding claim 3, *Adamske et al* with *Pineau* teach the system as defined in claim 2 wherein said user information is accessed through an extension component of said web browser (*Adamske et al—col.7 lines 4-9 and 16-27*).

Regarding claim 4, *Adamske et al* with *Pineau* teach the system as defined in claim 1 wherein said personal imaging repository stores the imaging data in a plurality of file formats (*Adamske et al—col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*).

Regarding claim 5, *Adamske et al* with *Pineau* teach the system as defined in claim 1 wherein said personal imaging repository comprises an imaging data store for storing imaging data (*Adamske et al—col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*).

Regarding claim 6, *Adamske et al* with *Pineau* teach the system as defined in claim 5 wherein said imaging data store is assigned to the user associated with said personal imaging repository for storing imaging data for user usage (*Adamske et al—col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*).

Regarding claim 7, *Adamske et al* teaches the system as defined in claim 5 wherein said imaging data store is assigned to a web service for storing imaging data available to the public (*col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*).

Regarding claim 8, *Adamske et al* with *Pineau* teach the system as defined in claim 1 wherein said personal imaging repository comprises a composition store for storing imaging compositions of imaging data serviced as a single unit (*Adamske et al—col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*).

Regarding claim 9, *Adamske et al* teach the system as defined in claim 8 wherein said imaging composition further comprising a link reference for each imaging data (*col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*).

Regarding claim 11, *Adamske et al* with *Pineau* teach the system as defined in claim 1 wherein said predefined format suitable for printing is page description language (*Adamske et al—col.2 lines 10-14*).

Regarding claim 12, *Adamske et al* with *Pineau* teach the system as defined in claim 11 wherein said predefined format suitable for printing is any one from the group consisting of: Postscript Format; Printer Control Language; and, Hewlett Packard Graphics Language (*Adamske et al—col.2 lines 10-14*).

Regarding claim 13, *Adamske et al* with *Pineau* teach the system as defined in claim 1, wherein said default format of said personal imaging repository is any one from the group consisting of: Joint Photographic Experts Group Format; Graphics Interchange Format; Portable Network Graphics Format; Tagged Image File Format; Portable Document Format; and, Microsoft Windows bitmap format (*Adamske et al—col.5 line 65-col.6 line 8*).

VI. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Adamske et al* (US 6,615,234) in view of *Stewart et al* (US 6,714,964).

Regarding claim 17, *Adamske et al* teach a method for preparing imaging data comprising digital data capable of being represented as two dimensional graphics for printing from an application located on a computer with a web browser and a capture driver having a printer driver to a requested web service provided by a web service server, wherein the computer is linked to a personal imaging repository having an imaging data store for storing the imaging

Art Unit: 2141

data and a composition store for storing imaging compositions having links to the imaging data serviced as a single unit, said method comprising the steps of:

- transferring the imaging data to the imaging data store (*col.4 lines 63-66*);
- creating an imaging composition having links to the imaging data stored in the imaging data store (*col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*);
- saving the imaging composition in the composition store (*col.5 line 65-col.6 line 8, col.7 lines 4-9 and 16-27*); and,
- directing the web browser to the requested web service (*col.3 lines 51-55*).

Adamske et al fails to explicitly teach a capture driver having a port monitor. However, *Stewart et al* teach a capture driver having a port monitor (*col.5 lines 42-56, col.5 line 65-col.6 line 7 and col.6 lines 20-22*). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system and method for network based document delivery of *Adamske et al* with *Stewart et al*'s system by having a capture driver having a port monitor because the port monitor is used to transfer information and for the verification of information.

Regarding claim 18, *Adamske et al* with *Stewart et al* teach the method according to claim 17 wherein prior to said step of transferring the imaging data further comprising the steps of: directing the imaging data to the operating system by the application; and, directing the imaging data to the printer driver by the operating system (*Adamske et al—col.3 lines 50-63*).

Regarding claim 19, *Adamske et al* with *Stewart et al* teach the method according to claim 17 wherein prior to said step transferring the imaging data further comprising the steps of: determining whether the imaging data is in a predefined format suitable for printing to a peripheral device; converting the imaging data to the predefined format when the imaging data is

Art Unit: 2141

not in the predefined format; and, directing the imaging data in the predefined format to the operating system (*Adamske et al—col.2 lines 8-16*).

Regarding claim 20, *Adamske et al* teach the method according to claim 19 wherein said step of directing the imaging data further comprising the steps of: converting the imaging data in the predefined format to a default format of the imaging data store (*col.2 lines 8-16*). Yet, *Adamske et al.* does not teach directing the imaging data in the predefined format to the port monitor; receiving the imaging data in the predefined format by the port monitor. However, *Stewart et al* teach directing the imaging data in the predefined format to the port monitor; receiving the imaging data in the predefined format by the port monitor (*col.5 lines 42-56, col.5 line 65-col.6 line 7 and col.6 lines 20-22*). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system and method for network based document delivery of *Adamske et al* with *Stewart et al's* system by directing the imaging data in the predefined format to the port monitor; receiving the imaging data in the predefined format by the port monitor because the port monitor is used to transfer information and for the verification of information.

Regarding claim 21, *Adamske et al* with *Stewart et al* teach the method according to claim 17 wherein prior said step of transferring the imaging data further comprising the step of converting the imaging data into a default format of the imaging data store (*Adamske et al—col.2 lines 8-16*).

Conclusion

VII. Any inquiry concerning this communication or earlier communications from the

Art Unit: 2141

examiner should be directed to Kristie D. Shingles whose telephone number is 571-272-3888.

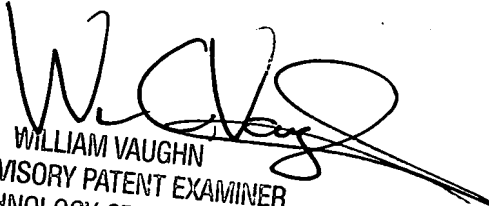
The examiner can normally be reached on Monday 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie D. Shingles
Examiner
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kds


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